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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/274,281	03/22/1999	JAY S. WALKER	WD2-99-006	8188

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EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/274,281

Applicant(s)

WALKER ET AL

Examiner

Sam Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-30,38,41-43,52,53,55 and 56 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 13-30,38,41-43,52,53,55 and 56 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/27/03

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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In view of the new grounds of rejection under 35 USC 101 , PROSECUTION IS HEREBY REOPENED, as set forth below. This office action is NON-FINAL.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 41-43, 52-53 and 55-56 are rejected under 35 USC 101 as being directory towards a non-statutory invention under 35 USC 101.

The claimed invention as a whole must accomplish a practical application. That is, it must produce a useful, concrete and tangible result. *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02, and MPEP 2106.

Each of claims 41-43, 52-53 and 55-56 are entirely directed to a claimed invention where the language of the claim raises a question as to whether the claim is directed to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful and tangible result to form the basis of statutory subject matter under 35 USC 101. In particular:

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Claim 41: The first six paragraphs of claim 41 can be accomplished by verbal interaction between a customer and a vendor. The last step can be accomplished by giving the customer cash or a check. No part of the claimed invention is tied to a technological art.

Claim 42: Claim 42 depends on claim 41 and pertains to the last step of claim 41.

Claim 43: The first six paragraphs of claim 43 can be accomplished by verbal interaction between a customer and a vendor. The last step can be accomplished by giving either the customer or the vendor cash or a check. No part of the claimed invention is tied to a technological art.

Claim 52: All of the paragraphs recited in claim 52 can be accomplished by verbal interaction between a customer and a vendor. No part of the claimed invention is tied to a technological art.

Claim 53: The first and second and fourth through ninth paragraphs of claims 53 can be accomplished by verbal interaction between a customer and a vendor. The paragraph of ascertaining of a rank (third paragraph) can be accomplished by mental memorization or by using a pencil and paper. None of the claimed invention is tied to a technological art.

Claim 55: The first through third paragraphs and fifth through eighth paragraphs can be accomplished by verbal interaction between a customer and a vendor. The fourth paragraph (selecting an offer) can be accomplished by mental steps or by having the vendor consult written records. No part of the claimed invention is tied to a technological art.

Claim 56: The first through third paragraphs and fifth through the eighth paragraphs can be accomplished by verbal interaction between a customer and a vendor. The fourth paragraph

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(selecting at least one offer) can be accomplished by mental steps or consulting written records.

No part of the claimed invention is tied to a technological art.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-30 and 38 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13: It is not clear if a relationship exists or does not exist between the “first amount of funds” and “second amount of funds”. This can be clarified by either reciting a relationship between the first amount of funds and the second amount of funds (i.e. “the second amount of fund are derived from the first amount of funds”) or by stating where the funds from the second vendor are being directed (i.e. “receiving funds from the second vendor at the first vendor”).

Claim 38: The last three steps of claim 38 calls for the charging of two different prices to a consumer account based upon a single transaction. As understood from the interview of May 7, 2002, this was a scenario where a user is charged the total price and subsequently granted a credit, having the net effect of charging the user a second price lower than the total price. Claim 38 can be clarified by indicating the second price is the result of the user having been granted a credit after being charged the first price.

Claims 13-30 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 41, 42, 43, 52, 53, 55 and 56 are rejected under 35 U.S.C. 102(e) as being anticipated by Barnett et al. (U.S. Patent 6,336,099).

Claim 41: FIG. 1 of Barnett et al. discloses the steps of transmitting an indication of at least one item that a customer intends to purchase, which is the step of transmitting user feedback data from the online service provider (2) or a retailer (10) to a coupon distributor (16). In response to this transmitted indication, the online service provider (2) receives indication of offers for subsidies, which are packages of coupons sent to the online service provider. The subsidies (coupons) are then provided to the customer, with the coupons being provided to the customer before a purchase is made with the coupons. The customer then accepts the offer by using the coupon in a retail store. The coupon acceptance is then transmitted to a coupon redemption database (13). The customer is charged a discounted price based upon the usage of the coupon at a retailer. As seen in FIG. 1, the coupon issuer then issues a discount reimbursement back to the retailer that redeemed the coupon.

Claim 42: The amount of funds reimbursed is based upon the usage of the coupon for a discount. It is illustrated in FIG. 1 as “discount reimbursement”.

Claim 43: See remarks for claims 41 and 42. The discount reimbursement is an amount of funds from a party other than the customer.

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Claim 52: See remarks for claim 41. A customer may reject an offer for subsidy (coupon) by deleting a coupon (col. 9, line 61) and instead accept the offers provided by other coupons.

Claim 53: See remarks for claim 41. Col. 7, lines 36-55 further describes an additional step in which the coupon redemption pattern by the consumer is analyzed, in order to decide which coupon offers are most appropriate for directing to the consumer in future coupon downloads. This reads as a ranking of the coupons, and the customer is provided only those coupons which are ranked as being most appropriate for that customer.

Claim 55: See remarks for claim 41. FIG. 1 further illustrates the transmission of "user redemption information" from the coupon redemption database (12) to the coupon distributor (16). This is described in greater detail at col. 7, line 41-55. The user redemption information reads as a historical acceptance rate, and dictates the selection of the coupons sent to the user.

Claim 56: See remarks for claim 41. Col. 13, lines 30-42 describe an additional step in which coupons with lower discounts are sent to known users of a brand, while coupons of a higher discount are sent to known users of a competitors brand. Since a lower discount translates into a higher profit, this reads on the step of selecting specific coupon offers based on their profitability.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 38 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnett et al. in view of Official Notice.

Claim 38: See remarks for claim 41. Barnett et al. differs from claim 38 in that it does not disclose the steps of charging a consumer a total non-discounted price to a credit card and then correcting this action by charging a corrected discounted price to a credit card.

However, Examiner takes Official Notice that it is well known in the art to correct a charge to a credit card when such a charge is found to be incorrect by a consumer. Typically, a consumer notifies the retailer of the discovery of the incorrect charge and the retailer electronically processes a credit to the consumer's credit card so that the correct amount is ultimately charged for a purchase. Alternatively, the retailer might credit back the entire purchase price and then re-process a new charge to the consumer which accurately reflects the purchase price.

It would have been obvious to one of ordinary skill in the art to modify Barnett et al. to allow retailers to apply credits to a consumer's credit card in order to provide for the correction of incorrect charges to a credit card, as is well known in the art.

Remarks

This office action is made non-final, as it includes new grounds of rejection under 35 USC 101 as set forth herein. Applicant retains the options of filing a reply under 37 CFR 1.111 or reinstating the appeal, as set forth in the beginning of this action.

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Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

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